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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,273	03/27/2000	Steven B. Smith	9311.6	3734
21999	7590	08/10/2005	EXAMINER	
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			MCCLELLAN, JAMES S	
		ART UNIT		PAPER NUMBER
		3627		
DATE MAILED: 08/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/536,273	SMITH, STEVEN B.
	<b>Examiner</b>	<b>Art Unit</b>
	James S. McClellan	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 30 June 2005.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 29-44 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/05 has been entered.

### ***Amendment***

2. Applicant's submittal of an amendment on 6/30/05 was entered, wherein:  
claims 25-44 are pending and  
claim 25 has been amended.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Pare, Jr. et al and Tracy et al. and the Stores publication by Gary Robins, entitled, "Portable POS", herein after Portable POS.

Fano teaches a PDA which is used in performing a wireless point-of-sale purchase transaction; the PDA comprises a microprocessor, a short range communication device which receives sales information from a wireless vendor device, a long range communication device which transmits purchasing information to a vendor including payment means (col. 47, line 58 through col. 52, line 15). While Fano teaches all the elements of the claimed invention, Fano fails to teach using the long-range communication for preauthorization of a purchase.

On the other hand, Pare, Jr. et al. teaches a tokenless, biometric transaction system which allows the purchaser to request authorization for a purchase. Pare, Jr. also teaches the authorization is transmitted to the vendor for the purchase of an item. It should also be noted Pare, Jr. et al. teaches a biometric input device.

Accordingly, to use the long range communication means of Fano to obtain 'a preauthorization for the purchase of an item, as suggested by Pare, Jr. et al., would have been obvious for one having ordinary skill in the art at the time of the invention. The advantage of such a modification to Fano would have been to provide greater security against fraud for the purchaser.

Fano fails to teach a vendor point of sale that includes a short-range communication device; however, Tracy et al. in col. 6, lines 26-51 teaches such a feature. Accordingly, to provide Fano with a vendor point of sale device as suggested by Tracy et al., would have been obvious for one having ordinary skill in the art at the time of the invention. The motivation for such a change would have been to promote sales for a vendor.

It is noted that all the references are silent regarding the preauthorization from a financial institution before the purchase of an item. However, the Portable POS publication teaches the

value of the portable device is not limited to the space inside the four walls. Mervyn's has used the portable out of doors to open charge accounts before the store opens, while people are waiting outside the store before the "SUPER" events.

The customer answers some questions, a major credit card is swiped through the magnetic stripe reader, and the system goes out to the credit bureau for the approval process. The system prints out a temporary credit card slip with a temporary I.D. number and the person's name. The customer also gets a discount coupon.

Accordingly, to add the step of preauthorization to the system of Fano, as taught by Portable POS, would have been obvious for the skilled artisan. The motivation for this change would have increased the sales for a business as well as adding convenience for the customer.

Claims 25-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al. in view of Pare, Jr. et al. Treyz et al. teach all the features of the claimed invention with the exception of a tokenless, biometric transaction system which allows the purchaser to request authorization for a purchase. As noted above Pare, Jr. et al. teach such a feature. Accordingly, Accordingly, to use the long range communication means of Treyz et al. to obtain a preauthorization for the purchase of an item, as suggested by Pare, Jr. et al., would have been obvious for one having ordinary skill in the art at the time of the invention. The advantage of such a modification to Treyz et al. would have been to provide greater security against fraud for the purchaser.

It is noted that Treyz et al. is silent regarding the preauthorization from a financial institution before the purchase of an item. However, the Portable POS publication teaches the value of the portable device is not limited to the space inside the four walls. Mervyn's has used

the portable out of doors to open charge accounts before the store opens, while people are waiting outside the store before the "SUPER" events.

The customer answers some questions, a major credit card is swiped through the magnetic stripe reader, and the system goes out to the credit bureau for the approval process. The system prints out a temporary credit card slip with a temporary I.D. number and the person's name. The customer also gets a discount coupon. Accordingly, to add the step of preauthorization to the system of Treyz et al., as taught by Portable POS, would have been obvious for the skilled artisan. The motivation for this change would have increase the sales for a business as well as adding convenience for the customer.

#### *Response to Arguments*

5. Applicant's arguments filed 6/30/05, have been fully considered but they are not persuasive.

On page 20, second paragraph, Applicant argues that Fano in view of the additional cited art fails to disclose a long-range communication device carried by the purchaser for initiating a request to an authorization processor. However, the claim does not clearly state that the purchaser's device "directly" communicates with the authorization processor. The claims merely state that the purchaser's device "initiates" a request. Communicating credit card transaction data with a point of sale terminal meets the broad limitation of initiating a request. As set forth in the office action, Pare, Jr. teaches the use of a long range communication device.

In response to applicant's argument (page 14) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, proper motivation was applied to each combination (see section 5 of the Office action).

### ***Conclusion***

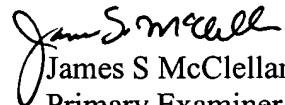
6. This is a RCE of applicant's earlier Application No. 09/536,273. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. McClellan whose telephone number is (571) 272-6786. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James S McClellan  
Primary Examiner  
Art Unit 3627

jsm  
8/5/05